



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,724	03/15/2004	Hansjorg Ander	3868-0156P	2073

2292 7590 01/20/2006

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

DESAI, ANISH P

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,724

Applicant(s)

ANDER ET AL

Examiner

Anish Desai

Art Unit

1771

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-20 is/are rejected.
- 7) ☒ Claim(s) 15-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II, Claims 14-20 in the reply filed on 01/03/06 is acknowledged. The traversal is on the ground(s) that the serious burden has not been placed on the Office to consider all of the claims in a single application and the step of filling the mass into the abhesive support cannot be eliminated as indicated by the examiner because if the preformed abhesive support has already a polymerizable mass within it, the mass must have been filled into the support. With respect to the applicant's argument that there is no serious burden on the Office to examine all of the claims. The examiner respectfully disagrees. In response the examiner would like to direct the applicant's attention to the Office action dated 12/01/05 in which the examiner has clearly demonstrated that there is a burden on the Office to examine all of the claims. Regarding, applicant's argument that the step of filling the mass into the abhesive support cannot be eliminated as indicated by the examiner because if the preformed abhesive support has already a polymerizable mass within it, the mass must have been filled into the support. The examiner agrees with the applicant. However, upon further consideration, the examiner notices that instead of curing the polymerizable mass by use of radiation, the polymerizable mass can be cured in the oven. Thus, the requirement is still deemed proper. The examiner respectfully reminds the applicant (s) of their right to request rejoinder of method claims with the product claims upon indication of the product claims as being allowable. The method claims must be commensurate with the allowed article claims, i.e. have been

amended to recite all the features of the allowed article claims. See In re Ochiai 37 USPQ2d 1127.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 03/15/03. It is noted, however, that applicant has not filed a certified copy of the 103 11 433.5 application as required by 35 U.S.C. 119(b).

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the citizenship of each inventor.

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

Drawings

4. The drawings were received on 03/15/04. These drawings are accepted.

Claim Objections

5. Claims 15-18 are objected to because of the following informalities: Claim 15 recites "Materials according to claim 14, characterized in that they have a round, circular, semi-circular, oval, elliptic, triangular, quadrangular, polygonal or irregular cross-sectional contour. In order to conform with the current US practice the phrase

such as “characterized in that” in claims 15-18 should be preferably changed to “wherein” and the claims should begin with the term “a” or “an”.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites, “Materials according to claim 14, characterized in that they are produced according to any one of the processes”. The claim is indefinite because it does not indicate which “processes” are used to “produce” the recited “Materials”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 14, 15, 18, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wambeke et al. (US 5,741,014).

Wambeke et al. teach a kit of parts, a device and a method for closing an end of a duct. The duct includes articles such as cable, pipe enclosures, cable splice closure housings (Column 1, lines 4-9). The kit of Wambeke et al. comprises a sealing material (Column 2, lines 30-33). The sealing material of Wambeke et al. comprises pressure

sensitive adhesive (Column 5, lines 34-35). Regarding claims 14 and 15, the sealing material 17 of Wambeke et al. as shown in Figures 4 and 5 has three dimensional structure and semi-circular cross-section. Moreover, at Column 8, lines 56-57, Wambeke et al. teach that other shapes of sealing material portions can be used depending on the shape of the duct. With respect to claims 19 and 20, the sealing material of Wambeke et al. as applied to the base claim 14 is capable of being used for the adhesive bonding of the objects and for sealing of joints or flanged joints or panes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wambeke et al. (US 5,741,014) in view of Bonk et al. (US 4,731,273)

The invention of Wambeke et al. as applied to the base claim 14 is previously disclosed. Wambeke et al. is silent as to teaching of sealing materials produced by polymerization of (meth) acrylates. However, Bonk et al. teach a polymeric sheet with a cross-linked pressure sensitive adhesive that can be used as a high strength closure (Column 1, lines 7-10). The invention of Bonk et al. is useful in sealing cable splice and electrical connectors (Column 1, lines 15-17). The pressure sensitive adhesive comprises acrylate terpolymers comprising monomers such as alkyl acrylate ester having from 1 to 4 carbon atoms in the alkyl group (Column 4, lines 10-11), which reads

Art Unit: 1771

on the (meth) acrylates as claimed in the claim 17. Additionally, at column 4, lines 29-30, Bonk et al. teach polymerization of acrylate terpolymers. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the pressure sensitive adhesive comprising acrylate terpolymer of Bonk et al. in the pressure sensitive adhesive sealing material of Wambeke et al., motivated by the desire to provide a high strength sealing material.

Regarding claim 16, the sealing material of Wambeke et al. is a continuous material and capable of being in the form of strips.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD

Hai Vo

**HAI VO
PRIMARY EXAMINER**